

Atty. Dkt. No. 072827-0372

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

This amendment adds, changes and/or deletes a claim in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Claim 1 is currently being amended. Support for the present amendments can be found throughout the patent application, for example see compounds 193, 194, and 195. Accordingly the amendments raise no issue of new matter.

The claim amendments are being made solely to advance prosecution of the application and to protect embodiments of particular interest to the Applicant. The amendments herein are in no way to be construed as an acquiescence to the rejections stated by the Examiner. Applicant reserves the right to pursue any cancelled subject matter in potential future divisional applications. After amending the claim as set forth above, claim 1 is now pending in this application.

Claim 1 is rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Lee (US 5,574,173), Boehringer (Fr 2277589), Banciu et al (Revue Romaine de Chimie, 1975, 20(1) pp. 121-7), Boehringer (DE 1793735), Tsvetkova et al (Khimiko-Farmatevticheski Zhurnal, 1969, 3(12), pp. 17-20), Boehringer (GB 1129029), and Judd et al (US 3,258,488). These rejections are respectfully traversed.

In order to anticipate a claim, a single prior art reference must provide each and every element set forth in the claim. *In re Bond*, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). *See also*, MPEP §2131. The Examiner bears the initial burden of establishing a *prima facie* case of anticipation. Only once that *prima facie* case has been established does the burden shift to the

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applicant to rebut the *prima facie* case. *See, e.g., In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

The present claims recite a compound of formula VIII shown in the specification wherein  $X^1$  and  $X^2$  are independently selected from the group consisting of -F, -CH<sub>3</sub>, -OH, and lower O-alkyl in the 1-, 3-, 7-, or 9-substituent positions, and wherein m can be 1 or 2. It is respectfully submitted that none of the above cited references teach a composition that meets the above limitations. Therefore it is respectfully submitted that the instantly amended claim is free of the prior art.

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CONCLUSION

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-0872.

Respectfully submitted,

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By 

FOLEY & LARDNER LLP  
Customer Number: 33588  
Telephone: (858) 847-6700  
Facsimile: (858) 792-6773

Stephen E. Reiter, Reg. No. 31,192  
For Richard J. Warburg, Reg. No. 32, 327  
Attorney for Applicant